

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

**M-8917 US**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on via EFS-Web on October 20, 2006

Signature \_\_\_\_\_

Typed or printed name Edward C. Kwok

Application Number

**09/696,446**

Filed

**10/24/2000**

First Named Inventor

**Carey B. Fan**

Art Unit

**2132**

Examiner

**Zand, Kambiz**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

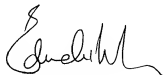
☒

attorney or agent of record. 33,938  
Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

**Edward C. Kwok**

Typed or printed name

**(408) 392-9250**

Telephone number

**October 20, 2006**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/696,446 Filing Date: October 24, 2000  
Confirmation No.: 3917  
First Named Inventor: Carey B. Fan  
Assignee: @ Road, Inc.  
Examiner: Zand, Kambiz Art Unit: 2132  
Attorney Docket No.: M-8917 US

San Jose, California  
October 20, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW**

Dear Sir:

These reasons support Applicants' Request for Pre-Appeal Brief Review, in response to the Final Office Action of April 21, 2006 ("Final Office Action").

Claims 1-6, 8-9 and 11-30 are pending and appealed.

The Examiner repeated his previous rejection of Claims 1-6, 8-9, 11 and 15-25 and 29-30 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 6,456,854 ("Chern") in the Office Action of November 28, 2005 ("Previous Office Action"). In response to the Previous Office Action, Applicants explained in the Response to Office Action of February 28, 2006 ("Previous Response") that independent Claims 1 and 17 each recite that the location timestamp is attached to an overhead portion of each message generated:

1. A messaging method comprising:  
generating a message from a mobile device, the  
message having significance independent of reporting a

geographical location of the mobile device; and

attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message.

17. A system including a mobile device, comprising:

a transmitter;

a locating device which provides a geographical location of the mobile device;

an interface to an application program presented to a user to allow a user generate a message having a significance independent of reporting a location of the mobile device; and

a control unit coupled to the transmitter, wherein for each message transmitted from the transmitter, the control unit receives the geographical location from the locating device and attaches a location stamp to an overhead portion of the message indicating the geographical location to the message.

(emphasis added)

Applicants pointed out that the limitations, which are discussed, for example, in Applicants' Specification, on page 9, at lines 6-15, provides significant benefits. In particular, by embedding the location stamp in the overhead portion of the message, the location stamp is transparent to application programs that do not take advantage of the location stamp. As a result, the present invention can be implemented without requiring modification of existing application programs, whether the application program is on the sender's side or on the recipient side. Embedding the location stamp in the overhead portion also prevents maliciously tempering with the location stamp at the application program. For these reasons, Applicants submit that Claims 1 and 17 are allowable over Chern, as Chern neither discloses nor suggest the limitations and their attendant benefits.

In response to Applicants' explanation in the Previous Response, the Examiner first argues in the Final Office Action:

Functionality: as long as the prior art teach the functionality of a process, where such functionality is being executed, then where such execution of the process is being done is irrelevant (in this case, appending the stamp location in the payload or header of a message makes no difference since the prior art do disclose such functionality on fig.4 and as applicant has also admitted in the arguments). Please also see a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing appending location stamp by GPS technology to the message.

Applicants respectfully disagree with the Examiner. By attaching the location stamp to the overhead portion, the structure of the overhead portion of the message is modified. Further, as explained above, as opposed to the payload, attaching the location stamp avoids a requirement that existing application programs be modified. Thus the limitations of Claims 1 and 17 recite both a difference in structure from prior art messages and a function that is not performed by a message of the prior art. As discussed in MPEP § 2114, no anticipation can be found when there is a structural difference:

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. It should be noted, however, that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999)

Thus, the Examiner's arguments are erroneous and thus should be rejected.

The Examiner then argues:

In response to applicant's argument that Prior art disclose the stamp location in payload of the message and not the header of the message, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The Examiner's arguments here are also erroneous. As explained above, by providing the location stamp in the overhead portion of the message, the structure of the overhead portion of a message is modified. Accordingly, a structural difference is recited. Thus, the Examiner's argument above should be rejected.

Finally, the Examiner states:

Applicant's arguments are not based on the essential element of the Applicant's invention. For example if having location stamp in the header is an inventive step over the prior art which teach the same functionality as pointed above, but is an inventive steps because result in different structure over the prior art and result in an improvement, then such differences must be specifically be present in the language of the claim and support for such differences should be clearly present in the specification.

Applicants respectfully submit that the Examiner is erroneous. The Examiner does not provide a basis -- and indeed has no basis -- for requiring an "inventive step" for patentability of the pending claims. Neither 35 U.S.C. § 102 nor 35 U.S.C. § 103 requires an "inventive step" for patentability. Thus, Applicants respectfully submit that the Examiner's requirement of an "inventive step" is not supported by U.S. laws and is therefore illegal and invalid. Moreover, Applicants Claims 1 and 17 specifically recite "attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message" and "attaches a location stamp to an overhead portion of the message indicating the geographical location to the message," respectively.

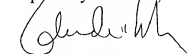
These limitations represent language that distinguishes over the prior art structurally and results in significant improvement over the prior art (i.e., provides functionality and benefits not found in the prior art). Accordingly, even if the Examiner's "inventive step" is required under U.S. Patent Laws, Claims 1 and 17 satisfy such a requirement.

The Examiner further rejected Claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,067,854 ("Ray"). As Claims 12-14 and 26-28 depend respectively from Claims 1 and 17, and are thus each allowable over Chern for the reasons stated above. As Ray also neither discloses nor suggests providing a location stamp in the overhead portion of a message, as recited in each of Claims 12-14 and 26-28, the Examiner's combination does not meet the limitations of the claims. Applicants respectfully submit that Claims 12-14 and 26-28 are each allowable over the combined teachings of Chern and Ray.

Accordingly, all claims (i.e., Claims 1-6, 8-9, 11-30 are therefore believed allowable. The Examiner's rejections of Claims 1-6, 8-9 and 11-30 should therefore be reversed.

If the Examiner has any question regarding the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicants at 408-392-9250.

Respectfully submitted,



Edward C. Kwok  
Attorney for Applicant(s)  
Reg. No. 33,938

Law Offices of  
MacPherson Kwok Chen & Heid LLP  
2033 Gateway Place, Suite 400  
San Jose, CA 95110  
Tel: (408) 392-9250  
Fax: (408) 392-9262